

REMARKS

Applicants respectfully request reconsideration in view of the amendment and following remarks. The amendment to claims 13, 28, 29 and 38 is supported by page 1, lines. 29-31, where it is disclosed, that the one-part BX concentrate can be diluted with water and can be used as a regenerator. This is also where support for newly added claim 40 can be found. Present claims 13, 28, 29 and 38 claim the concentrate that is diluted with water before use. The amendment in claims 18 -20 and 34 -36 is supported by page 3, lines 25-27 of the specification. Again, support for newly added claim 40 can be found in claim 13 and in the specification at page 1, lines 28-31. The remaining amendments are just rearrangements within the claims.

Claims 18, 19, 20 (with respect to the broadening scope of "inorganic acid", 25, 26, 27, 34, 35, 36 (with respect to the broadening scope of "inorganic acid", 37 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meckl *et al.* U.S. Patent No. 3,293,036 ("Meckel"), Papai U.S. Patent No. 6,455,236 ("Papai") and McGuckin *et al.* U.S. Patent No. 6,096,489 ("McGuckin"). Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkubo *et al.* U.S. Patent No. 3,591,380 ("Ohkubo "), Papai and McGuckin. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schranz *et al.* U.S. Patent No. 3,879,203 ("Schranz"), Papai and McGuckin. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papai and McGuckin. The applicants respectfully traverse these rejections.

35 U.S.C. 112, First Paragraph Rejection

Claims 18, 19, 20 (with respect to the broadening scope of "inorganic acid", 25, 26, 27,

34, 35, 36 (with respect to the broadening scope of "inorganic acid", 37 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The present claims 18-20 and 34 - 37 no longer refer to an inorganic acid, so that their objection should be withdrawn. Claims 25-27 and 39 have been canceled.

The Examiner also questioned support for the phrase "in amount sufficient to ... form storage stable." (see page 2, paragraph II and page 4, paragraph V of the Office Action). The applicants have support for this phrase.

On page 2, lines 1-2 of the specification, reference is made to "the aforementioned decomposition of the thiosulphate" and according to page 2, lines 5 to 8 of the specification, this can be overcome by the addition of phosphate, polyphosphate or polyphosphorate. Needless to say, that these ions have to present in an amount to achieve this target to be useful in the present invention. The "aforementioned decomposition of thiosulfate" is described on page 1, lines 14-17 for BX baths, where it is said, that they "cannot be held for an extended period in the same solution" because of this decomposition.

As the term "held for an extended period" is a synonym for "storage", the feature of pending claims 13, 28, 29 and 38 "in an amount sufficient to form a storage stable" is not only supported by the examples, but also by the specification as described above. Therefore, this objection should be withdrawn.

Prior Art Rejections

Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meckl *et* Papai and McGuckin. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkubo, Papai and McGuckin. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Schranz, Papai and McGuckin. Claims 13-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papai and McGuckin. The applicants respectfully traverse these rejections.

The Examiner's rejections are based on the term "concentrate" used in the claims not being given patentable weight. The Examiner is of the opinion that concentrate is not patentably different from a ready-to-use (bleach-fixing) composition.

The Examiner argues according to the absolute concentration of the chemical ingredients when comparing the concentrates of the present invention and the ready-to-use bleach-fixing compositions according to the cited prior art. Indeed the absolute concentration is of importance, because the undesired decomposition and crystallization gets worse with increasing concentration of the ingredients.

The present invention is directed to a "one-part concentrate". A person skilled in the art would not understand a "one-part concentrate" as a ready-to-use bath that is directly used to process the material, but as a solution that is pre-prepared and then a) diluted to get a ready-to-use bath or regenerator or b) used as a regenerator. However, the concentrate necessarily has a higher concentration than the ready-to-use bath prepared from this concentrate. The applicants have amended pending to make this meaning of the term "concentrate" clear.

Therefore, the term "concentrate" makes applicants' invention new over the prior art. A person skilled in the art will interpret a concentrate as a pre-prepared solution that has been produced in concentrated form to save storage and shipping costs and that can be stored under specified conditions for a long time.

It is evident from the examples of the present invention that applicants' invention is directed to one-part concentrates having an improved storage stability. Example 1 demonstrates the effect of the present invention in a forced storage test. The decomposition time of the sulphite was tested at 60 °C, what is a good simulation of long time storage stability in this case. The immediately used solution ("No storage") is not significantly influenced by the addition of phosphates, but the stored concentrates according to the present invention surprisingly shows better sulphite stability.

Example 2 demonstrates the advantages of the present invention under cool storage conditions (-5 °C). Even after five days storage, the comparison concentrates show a deposition of crystals that decrease the available content of active ingredients. This test cannot be forced by a higher, but by a lower temperature, because the crystallization of compounds is generally promoted by lower temperatures.

Usually a concentrate is stored at low temperature for a long time, whereas a ready-to-use solution is heated immediately after its preparation to the process temperature, *e.g.* 38 °C (see Example 14, page 78, line 45 of EP 532 042) and is used for the photographic processing.

When a concentrate of the present invention is used as a replenisher or a regenerator, again it will be diluted with water in most cases. However, depending on the processing apparatus used, it can also be directly injected in the BX processing tank to replenish or regenerate the BX bath.

None of the cited references, Meckl, Ohkubo or Schranz disclose a concentrate that is diluted before use (claims 13, 28, 29, 38 and 40).

The definition of the concentrate according to the present claims should now be patentably different over a ready-to-use solution, so that such rejections should be withdrawn.

For the above reasons, these rejections should be withdrawn.

Papai is not applicable art because the applicants' priority documents antedate Papai. The applicants have previously submitted a certified English translation of the priority document which the applicants believe entitles them to a May 27, 2000 filing date of which is prior to the filing date of November 17, 2000 which is the filing date of Papai. The applicants do not believe that the 'Papai s entitled to the filing date of January 6, 2000 because the claimed invention is not completely supported by the continuation-in-part application.

Support for at least one species in the claims in the priority document filed May 27, 2000 is as follows: Support for at least one species that has the features of claims 13, 28, 29, 38 and 40 can be found in the original claim 1, the example and the specification at page 1, lines 26-29. Support for newly added claims 14 and 30 can be found in the specification at page 1, lines 9-15 and page 2, lines 1-3 and the example. Support for newly added claims 15 and 31 can be found at page 3, line 21 and the original claim 3. Support for at least one species for claims 16, 17, 32 and 33 can be found in the specification at page 2, the last paragraph. Support for at least one species for claims 18 and 34 can be found in the specification at page 3, lines 16-19. Support for at least one species for claim 19, 21, 35 and 37 can be found in the specification at page 3, lines 26-30.

A two month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 07244-00144-US from which the undersigned is authorized to draw.

Respectfully submitted,

By

Ashley I. Pezzner

Registration No.: 35,646

CONNOLLY BOVE LODGE & HUTZ LLP

1007 North Orange Street

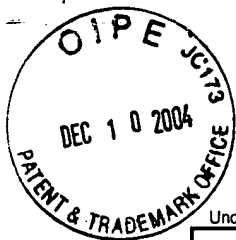
P.O. Box 2207

Wilmington, Delaware 19899

(302) 658-9141

(302) 658-5614 (Fax)

Attorney for Applicant



PTO/SB/92 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Application No. (if known): 10/668579

Attorney Docket No.: 12980-00008-US

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

MS AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on December 6, 2004
Date


Signature

J. Lynn Ferry

Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Amendment In Response To Non-Final Office Action
Petition For Extension Of Time
Fee Transmittal for FY 2005
Charge \$430.00 to deposit account 03-2775